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10/825,950

04/16/2004

Steven L. VanFleet

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09/22/2008

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EXAMINER

AGWUMEZIE, CHARLES C

ART UNIT

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3685

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/825,950

**Applicant(s)**

VANFLEET ET AL.

**Examiner**

CHARLES C. AGWUMEZIE

**Art Unit**

3685

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) 22-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 and 27-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date 11/25/07.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application.
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 17, 2008 has been entered.

### **Acknowledgments**

2. Applicants' amendment filed on June 16, 2008 is acknowledged. Accordingly claims 1-21 and 27-38 remain pending.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 1, 15, 16, and 27**, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed contains no support for "wherein the credential is a universal payment mechanism which allows the customer to maintain a single payment mechanism for the plurality of accounts each with a different account type". There are new claims without support in the specification. This is the first instance of this invention that is unrelated and unsupported by the original filing. Cancellation of the new matter is required.

Applicant's amendments/arguments filed June 16, 2008 have been considered but are deemed without merit since the applicant argues an invention lacking support in the specification and based entirely on new matter.

Claims 2-14, 17-21, and 28-38 are also rejected for being dependent directly or indirectly from independent claims 1, 16 and 27.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. **Claims 1, 4, 6, 8-15, 27, 30, 33-38**, are rejected under 35 U.S.C. 102(e) as being anticipated by Pitroda U.S. Patent Application Publication No. 2005/0247777 A1.

7. As per claims 1, 15, and 27, Pitroda discloses a computerized method comprising:

receiving, at a payment network, a first information packet from a merchant, the first information packet including a cost of a financial transaction between the merchant and a customer and a credential presented by the customer as a payment for the financial transaction (0099, which discloses sending the information received from the UET card ....including the amount of the transaction...);

wherein the credential is associated with a plurality of accounts each with different account types the association maintained on behalf of the customer by the payment network, wherein the credential is a universal payment mechanism which allows the customer to maintain a single payment mechanism for the plurality of accounts each with a different account type (see figs. 1, 12, 13 and 14, which discloses consolidated financial accounts of varying types into a single instrument; 0020, which discloses selecting from UET card a service institution account from a group of service institution accounts...; 0022; 0023; 0039; 0040; 0098; 0099);

using the credential to determine, with the payment network, account information that identifies the plurality of accounts maintained by the payment network and authorization information that allows access to the plurality of accounts (0020, which discloses selecting from UET card a service institution account from a group of service institution accounts...; 0022; 0023; 0039; 0040; 0098; 0099);

generating, at the payment network, a second information packet comprising the account information and the authorization information (0100, which discloses that the American Express service then provides a credit check and if appropriate, sends an authorization code to the CIU....);

selecting one of the plurality of accounts and directing a financial transaction network which correspond to the type of the selected account to transmit the second information packet to the financial institution of the type of the selected account (0020, which discloses selecting from UET card a service institution account from a group of service institution accounts...; 0022; 0023; 0039; 0040; 0098; 0099);

transmitting from the payment network the second information packet to the financial institution using the financial transaction network, with a request to perform a debit transaction from the selected account for at least a portion of the cost of the financial transaction (0020, which discloses transmitting from the point transaction system to the service institution system transaction informational information for the credit transaction...; 0099; 0100).

8. As per claims 4, and 30, Pitroda further discloses the method, further comprising:

receiving, at the payment network, a response from the financial institution indicating approval or denial of the debit transaction (0096, which discloses approves the user; 0099); and

transmitting, from the payment network, an authorization code to the merchant indicating approval or denial of the financial transaction in accordance with the response received from the financial institution (0100, which discloses that the American Express service then provides a credit check and if appropriate, sends an authorization code to the CIU....).

9. As per claims 6 and 36, Pitroda further discloses the method, wherein:

the account information comprises a primary account number for the identified financial account (0099; 0100); and

the authorization information comprises a personal identification number assigned to the customer for accessing the identified financial account (0096, which discloses identify the user, either through a PIN code given to the user by the service institution; 0100).

10. As per claims 8 and 33, Pitroda further discloses the method, wherein selecting one of a plurality of financial transaction networks comprises selecting an automated clearing house ("ACH") network (see fig. 30).

11. As per claims 9 and 34, Linehan further discloses the method, wherein selecting one of a plurality of financial transaction networks comprises selecting a debit system (see figs. 12-14).

12. As per claims 10 and 35, Pitroda further discloses the method, wherein selecting one of a plurality of transaction financial networks comprises selecting a direct network path to the financial institution from the payment network (0099; 0100).

13. As per claims 11 and 37, Pitroda further discloses the method, wherein the credential comprises a payment network account number assigned to the customer to access the payment network (0099; 0100).

14. As per claim 12, Pitroda further discloses the method:

wherein the credential further comprises a personal identification number (PIN)  
(see fig. 11, 0087; 0096); and

wherein the method further comprises verifying, with the payment network, the PIN is associated with the payment network account (0087; 0096; 0099).

15. As per claims 13 and 38, Pitroda further discloses the method, further comprising crediting, with the payment network, a loyalty program for the customer in response to execution of the financial transaction (0009, which discloses cash back rebates).



16. As per claim 14, Pitroda further discloses the method, wherein receiving the first information packet comprises receiving the first information packet from an Internet merchant and wherein the financial transaction is an Internet-based financial transaction (0028).

17. Claims 2, 3, 5, 7, 16-19, 28-29, and 31-32, are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda U.S. Patent Application Publication No. 2005/0247777 A1 in view of Linehan U.S. patent No. 6,327,578 B1.

18. As per claim 2 and 28, Pitroda failed to explicitly disclose the method, further comprising using the credential to determine, with the payment network, second account information that identifies a second financial account maintained by the customer at one of the financial institution and a second financial institution and second authorization information that allows debit access to the identified second financial account.

Linehan further discloses the method, further comprising using the credential to determine, with the payment network, second account information that identifies a second financial account maintained by the customer at one of the financial institution and a second financial institution and second authorization information that allows debit access to the identified second financial account (col. 4, lines 45-55; apply the transaction amount to consumer's credit card or deposit account...; col. 10, lines 50-60;

col. 12, lines 50-55; divide payments into two or more portions that are separately authorized...).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Pitroda and incorporate the method, further comprising using the credential to determine, with the payment network, second account information that identifies a second financial account maintained by the customer at one of the financial institution and a second financial institution and second authorization information that allows debit access to the identified second financial account in view of the teachings of Linehan since the claimed invention is merely a combination of old and known elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in art would have recognized that the results of the combination were predictable.

**19.** As per **claim 3 and 29**, Pitroda failed to explicitly disclose the method further comprising:

determining, at the payment network, an apportionment of the cost among the first and second financial accounts;

generating, at the payment network, a third information packet comprising the second account information, the second authorization information, and a portion of the cost to apply to the second financial account in accordance with the apportionment; and wherein the second information packet further includes a second portion of the cost to apply to the financial account in accordance with the apportionment

Linehan further discloses the method, further comprising:

determining, at the payment network, an apportionment of the cost among the first and second financial accounts (col. 12, line 50-col. 13, line 30; divide payments into two or more portions that are separately authorized...);

generating, at the payment network, a third information packet comprising the second account information, the second authorization information, and a portion of the cost to apply to the second financial account in accordance with the apportionment (col. 12, line 50-col. 13, line 30; split payments with separate authorizations...);

and wherein the second information packet further includes a second portion of the cost to apply to the financial account in accordance with the apportionment (col. 12, line 50-col. 13, line 60).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Pitroda and incorporate the method, further comprising determining, at the payment network, an apportionment of the cost among the first and second financial accounts; generating, at the payment network, a third information packet comprising the second account information, the second authorization information, and a portion of the cost to apply to the second financial account in accordance with the apportionment; and wherein the second information packet further includes a second portion of the cost to apply to the financial account in accordance with the apportionment in view of the teachings of Linehan since the claimed invention is merely a combination of old and known elements, and in the combination each element would have performed the same function as it did separately,

and one of ordinary skill in art would have recognized that the results of the combination were predictable.

**20.** As per claims 5, and 31, Pitroda failed to explicitly disclose the method further comprising:

performing, with the payment network, a risk analysis of the financial transaction;  
and determining, with the payment network, whether to provide a guarantee of the financial transaction to the merchant based on the risk analysis, wherein the authorization code further reflects whether the guarantee is provided

Linehan further discloses the method, further comprising:

performing, with the payment network, a risk analysis of the financial transaction (col. 13, lines 1-30; gateway verifies split payment ...according to its risk management policies...); and

determining, with the payment network, whether to provide a guarantee of the financial transaction to the merchant based on the risk analysis, wherein the authorization code further reflects whether the guarantee is provided (col. 4, lines 45-65; ...undeniable proof that the issuer authorized the payment...).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Pitroda and incorporate the method, further comprising performing, with the payment network, a risk analysis of the financial transaction; and determining, with the payment network, whether to provide a

guarantee of the financial transaction to the merchant based on the risk analysis, wherein the authorization code further reflects whether the guarantee is provided in view of the teachings of Linehan since the claimed invention is merely a combination of old and known elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in art would have recognized that the results of the combination were predictable.

**21.** As per claims 7 and 32, Pitroda failed to explicitly disclose method wherein selecting one of a plurality of transaction networks comprises:

performing, with the payment network, a risk analysis of the financial transaction;  
and

selecting the financial transaction network based on the risk analysis.

Linehan further discloses the method, wherein selecting one of a plurality of transaction networks comprises:

performing, with the payment network, a risk analysis of the financial transaction (col. 13, lines 1-30; gateway verifies split payment ...according to its risk management policies...); and

selecting the financial transaction network based on the risk analysis (col. 13, lines 1-30; gateway verifies split payment ...according to its risk management policies...).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Pitroda and incorporate the method,

wherein selecting one of the plurality of transaction networks comprises performing, with the payment network, a risk analysis of the financial transaction; and selecting the financial transaction network based on the risk analysis in view of the teachings of Linehan since the claimed invention is merely a combination of old and known elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in art would have recognized that the results of the combination were predictable.

**22.** As per claim 16, Pitroda discloses a computerized method comprising:

receiving, at a payment network, an information packet from a merchant, the information packet including a cost of a financial transaction between the merchant and a customer and a credential assigned to the customer for the financial transaction (0099, which discloses sending the information received from the UET card ....including the amount of the transaction...),

wherein the credential is associated with a plurality of accounts each with different account types the association maintained on behalf of the customer by the payment network, wherein the credential is a universal payment mechanism which allows the customer to maintain a single payment mechanism for the plurality of accounts each with a different account type (see figs. 1, 12, 13 and 14, which discloses consolidated financial accounts of varying types into a single instrument; 0020, which discloses selecting from UET card a service institution account from a group of service institution accounts...; 0001; 0022; 0023; 0039; 0040; 0098; 0099);

using the credential to determine, with the payment network, account information identifying the plurality of accounts maintained by payment network (0020, which discloses selecting from UET card a service institution account from a group of service institution accounts...; 0022; 0023; 0039; 0040; 0098; 0099);

using the credential to determine, with the payment network, authorization information for each of the identified financial accounts that allows access to the identified plurality of accounts (see fig. 15; 0001, which discloses functioning as a number of different credit cards...);

determining, at the payment network, an apportionment of the cost to apply to each of the plurality of the accounts;

generating, at the payment network, a plurality of authentication packets for each of the plurality of accounts, each authentication packet comprising account information for one of the plurality of accounts, authorization information for the account, and the determined apportionment of the cost to apply to the account (0001, which discloses issuing an account authorization to a UET card ... capable of functioning as a number of different credit cards ...; 0020, which discloses transmitting authorization for the credit transaction to the point of sale transaction system...);

selecting one of the plurality of accounts and directing a financial transaction network which correspond to the type of the selected account to transmit the second plurality of authentication packets to the financial institution of the type of the selected account (0020, which discloses selecting from UET card a service institution account

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from a group of service institution accounts...; 0022; 0023; 0039; 0040; 0098; 0099);  
and

transmitting from the payment network using the selected financial transaction network, each of the authentication packets to the respective financial institution of the type of selected account (0020, which discloses transmitting authorization for the credit transaction to the point transaction system ...; 0099; 0100).

**23.** What Pitroda does not explicitly disclose is:

determining, at the payment network, an apportionment of the cost to apply to each of the plurality of the accounts;

**24.** Linehan discloses:

determining, at the payment network, an apportionment of the cost to apply to each of the plurality of the accounts (col. 12, lines 50-55; ...divide payments into two or more portions that are separately authorized...);

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Pitroda and incorporate the method, comprising determining, at the payment network, an apportionment of the cost to apply to each of the plurality of the accounts in view of the teachings of Linehan since the claimed invention is merely a combination of old and known elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in art would have recognized that the results of the combination were predictable.



**25.** As per **claims 17 and 19**, Pitroda further discloses the method, further comprising receiving,

at the payment network, a response to one of the authentication packets indicating denial of the debit transaction (0096, which discloses approves the user; 0099); and

transmitting an additional authentication packet comprising account information for a second one of the identified financial accounts different from the financial account associated with the denied authentication packet, authorization information for the second financial account, and the determined apportionment of the cost comprised by the denied authentication packet (0100, which discloses that the American Express service then provides a credit check and if appropriate, sends an authorization code to the CIU).

**26.** As per **claim 18**, Pitroda further discloses the method, further comprising:

receiving a response to the additional authentication packet indicating denial of the debit transaction (0011; 0013; 0015); and

transmitting, from the payment network, an authorization code to the merchant indicating denial of the financial transaction (0100; 0017; 0018; 0020).

**27.** **Claims 20 and 21**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda U.S. Patent Application Publication No. 2005/0247777 A1 in view of

Linehan U.S. Patent No. 6,327,578 B1 and further in view of Cohen U.S. Patent No. 6,422,462 B1.

**28.** As per **claim 20**, both Pitroda and Linehan failed to explicitly disclose the method, wherein determining an apportionment of the cost comprises apportioning the cost equally among the identified financial accounts.

**29.** Cohen discloses the method, wherein determining an apportionment of the cost comprises apportioning the cost equally among the identified financial accounts (col. 9, lines 45-55; ...distributed over plurality of cards...designating particular sum...).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Pitroda and incorporate the method, wherein determining an apportionment of the cost comprises apportioning the cost equally among the identified financial accounts in view of the teachings of Cohen since the claimed invention is merely a combination of old and known elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in art would have recognized that the results of the combination were predictable.

**30.** As per **claim 21**, both Pitroda and Linehan failed to explicitly disclose the method, wherein determining an apportionment of the cost comprises using an allocation apportionment specified by the customer.

31. Cohen discloses the method, wherein determining an apportionment of the cost comprises using an allocation apportionment specified by the customer (col. 9, lines 45-55).

Accordingly, it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Pitroda and incorporate the method, wherein determining an apportionment of the cost comprises using an allocation apportionment specified by the customer in view of the teachings of Cohen since the claimed invention is merely a combination of old and known elements, and in the combination each element would have performed the same function as it did separately, and one of ordinary skill in art would have recognized that the results of the combination were predictable.

### **Conclusion**

32. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The reference cited to Padam U.S. Patent Application Publication No. 2004/0080692 A1 is a document considered relevant to the claimed invention.

**Examiner's Note:** Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that the applicant, in preparing the responses, fully consider the references in entirety as potentially teaching all or part of

the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles C. Agwumezie whose number is **(571) 272-6838**. The examiner can normally be reached on Monday – Friday 8:00 am – 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on **(571) 272 – 6709**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Charlie C Agwumezie/  
Primary Examiner, Art Unit 3621  
September 5, 2008